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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,154	07/24/2000	Peter Godlewski	16166-001800US	5073

20350 7590 09/05/2002

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/624,154

Applicant(s)
Godlewski et al

Examiner
Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 6, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 31-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jul 24, 2000 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 & 5 6) ☐ Other:

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DETAILED ACTION

Restriction & Election of Species

1. Applicants' election without traverse of Invention I (claims 1-15 and 31-35) in Paper No. 8 is acknowledged.
2. Applicants' election without traverse of Species I represented by figure 1 (claims 1-15 and 31-35) in Paper No. 8 is also acknowledged.
3. Because Applicants state that "the dispensing cabinets in Figs. 1 and 2 are merely examples of different types of dispensing cabinets that would be used with the methods set forth in claims 1-15 and 15-35", it appears that claims 1-15 and 15-35 are generic claims. Because of these statements by Applicants, the Election of Species (from Paper No. 6) is hereby withdrawn.

Acknowledgments

4. The amendment filed August 6, 2002 (part of Paper No. 8) is acknowledged. Accordingly, claims 1-15 and 31-35 remain pending.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claims:

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- a. The “periodically sending restocking information” as recited in claim 1, 31, and 32.
 - b. The “producing one or more pages on the display screen” as recited in claim 5.
 - c. The “generating one or more purchase order numbers” as recited in claim 6.
6. The Examiner notes the claims are replete with the above drawing errors. All method steps recited in claim 1-15 and 31-35 are clearly not shown in the drawings. The Examiner highly recommends Applicants review all 20 claims to ensure that every method step recited is shown in the drawings. If Applicants need additional information on this topic or would like further assistance on this matter, Applicants may contact the Examiner at the number listed below.
7. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.
9. Claims 1-15 and 31-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims are replete with errors. Some examples follow:

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a. Regarding claims 1, 31, and 32, the phrase “type” renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by “type”), thereby rendering the scope of the claim(s) unascertainable. See MPEP §2173.05(b) *E*.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

11. Claims 1-6 and 31-35, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Salvo et. al. (U.S. 6,341,271 B1, hereinafter “Salvo”). Salvo discloses the following: hosted applications (the computer programs running the system); providing a plurality of dispensing units (storage receptacle 104) that each hold a plurality of at least one type of item (e.g. mixed feed), the units have processor and memory (inherent); periodically sending restocking information from the dispensing units over a network to a server computer (service center 175 or control unit 114, see also column 9, lines 46-47) wherein the restocking information includes restock quantity for each item (inherent); polling the dispensing

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units (with the inventory policy models) over the network using the server computer (at periodic intervals, column 11, lines 39-40); generating the ordering information (quantity to be ordered) using the server computer and determining supplier information (from which supplier for the items ordered (different vendors, column 7, lines 47-50 and column 9, lines 33-57 for automatically and electronically ordering); viewing one or more pages on a display screen to permit ordering information to be approved, modified or canceled (column 7, line 55 thru column 8, line 25); the system generates electronic purchase orders with numbers (inherent since the orders must be tracked); electronically sending advanced shipping notice (based on trends and forecasts and shipping information, column 9, lines 24-25), the advanced shipping includes items to be shipped, quantities, and data of shipping (all inherent in shipping tracking and in the transportation advisory system, column 9, lines 18-57; and "order location" column 10, lines 48-51); information that is not stocked is transmitted (inherent since alternative products from various vendors is sent and analyzed (e.g. hazardous material); once delivered, reconciling the dispensing processor and electronically sending confirmation over the network (inherent in serial and parallel communications); and providing manual selection of suppliers (via a paper order, column 9, lines 58-65); electronic quotes of inventories (from the various vendors); generating an aggregate list of items (items needed for the plant) and quantities (inherent); and manually ordering items that are not on the list (confirmation of a paper order, column 9, lines 58-65); the ordered items are on consignment (inherent).

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12. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).¹

However, if Applicants do desire any claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicants in their next response to expressly indicate the claim limitation at issue² and to show where in the

¹ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

² “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or

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specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).³ The Examiner cautions that no new matter is allowed.

Failure by Applicants in their next response to address this issue or to be non-response to this issue entirely will be considered a desire by Applicants to give all claim limitations their

otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

³ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

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ordinary and accustom meaning. The claims are then interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁴ Applicants are cautioned that even though claim interpretation begins with this presumption, any interpretation disclaimed during prosecution may still further limit that claim element. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001).

13. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

14. Functional recitation(s) using the word “for” and “to” (e.g. “for suppling items to a plurality of dispensing units” as recited in claim 1 and “to permit” as recited in claim 33) have been given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states

⁴ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

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only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 7-11, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Salvo. Salvo discloses as discussed above but does not directly disclose the various computers (e.g. portal computers). The Examiner takes Official Notice that systems can contain a network of computers with each computer having a different task (e.g. LAN or WAN).

Alternatively, Applicants are reminded that “it is generally the rule that patentability of a method claim must rest on the method steps recited, not on the structure used, unless that structure affects the method steps.” *Leesona Corp. v. US*, 530 F.2d 896, 908 (US Ct Clms 1976). In this case, it does not make a difference whether its a single computer or a “portal computer” which sends and receives the electronic messages. In other words, the structure of a portal computer or Salvo’s computers does not effect the method steps of sending and receiving the actual information. The structural differences of the computers does not effect the method steps.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Salvo to substitute applications and business portal computers for the computers disclosed in Salvo. Such a modification would have made expansion easier since the computers would have been more modular.

17. Claims 12-15, as understood by the Examiner, are also rejected under 35 U.S.C. 103(a) as being unpatentable over Salvo.⁵ Salvo discloses as discussed above but does not directly disclose confirmation of receipt.

It is the Examiner's principle position that receipts are inherent in Salvo since virtually all electronic purchase exchanges include receipts. However, if not inherent, the Examiner takes Official Notice that receipts are sent for confirmation purposes in electronic commerce.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Salvo to include sending confirmation receipts from the dispensing units to the server computer. Such a modification would have detected faults and provided an easy check of system performance and troubleshooting.

18. Claim 31, as understood by the Examiner, is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Salvo.⁶ It is the Examiner's principle position that Salvo discloses

⁵ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

⁶ Id.

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items on consignment since many inventories are on consignment and Salvo discloses factory inventories.

However, if not inherent, the Examiner takes Official Notice that items from external suppliers are sold on consignment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Salvo to include factory items from external suppliers sold on consignment. Such a modification would have allowed the factory to reduce inventory costs by paying for materials only after they are used and sold (left the factory).

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure includes the following: Purcell (WO 97/44749); Peterson et. al. (U.S. 6,324,522 B2); Roden et. al. (U.S. 6,249,774 B1); Sakata (U.S. 6,115,649); Purcell (U.S. 6,081,789); Ettl et. al. (U.S. 5,946,662); Yamamoto et. al. (U.S. 5,914,878); Sheldon et. al. (U.S. 5,765,143); Tone et. al. (U.S. 5,596,493); O'Connor (U.S. 5,400,253); and Johnson et. al. (U.S. 6,023,683).

20. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

21. The art unit and technology center for this application has changed. The new art unit is 3627 in technology center 3600. So that papers may be properly matched, please indicated the new art unit on any paper submitted with this application.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

 8/30/02
ANDREW J. FISCHER
PATENT EXAMINER

AJF
August 30, 2002